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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,998	01/17/2002	Nicholas J. Elsey	41698-1036	9128

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Alex L. Yip  
Kaye Scholer LLP  
425 Park Avenue  
New York, NY 10022

EXAMINER
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CHOULES, JACK M

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/051,998

**Applicant(s)**

ELSEY ET AL.

**Examiner**

Jack M Choules

**Art Unit**

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 29-50 and 75-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 51-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-92 are presented for examination. Claims 29-50 and 75-92 were in non-selected groups. Claims 1-28 and 51-74 being acted upon below.

#### *Election/Restrictions*

2. Applicant's election with traverse of claims 1-28 and 51-74 in the reply filed on 2 July 2004 is acknowledged. The traversal is not specifically set forth as no particular arguments are set forth. This is not found persuasive because no specific arguments set forth.

The requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election of claims 1-28 and 51-74 in the reply filed on 2 July 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 29-50 and 75-92 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2 July 2004.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-8, 10, 51-53, 55, 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Marwell et al. Patent No. US 6,404,884.

8. As to claims 1 and 51, Marwell teaches a system comprising: “a database” (column 5, lines 55-62); an interface for receiving communication calls...” (column 9, lines 61-67, and column 10 lines 1-2 and 42-49); “one or more devices...” (column 9, lines 21-30); and “a processor for deriving information” (column 9, lines 61-67, and column 10 lines 1-2 and 42-49). The data is considered to be the “automatic number identification (ANI) data string” (column 9, line 29) and the derived information is the identification of the personal contact list associated with the callers telephone ID (column 9, line 67 and column 10, line 1) the processor is inherent to terminal 18 and/or database 16 as a query is run on the database.

9. As to claims 2, 3, 52, and 53, Marwell teaches “wireless telephones” (column 4, lines 50-59).

10. As to claims 4, Maxwell teaches including “a personal information manager (PIM)” (column 17, lines 6-43).

11. As to claims 5 and 6, Marwell teaches “switching facilities” (column 4, lines 50-59).

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12. As to claims 7, Marwell teaches, “accessing the database” (column 9, lines 61-67, and column 10 lines 1-2 and 42-49).

13. As to claims 8, 10, 55, and 57, Marwell teaches “data concerns events” (column 9, lines 61-67, and column 10 lines 1-2 and 42-49) the telephone ID of caller concerns the events of searching for entities as it is used in the search for the contact list which would be a list of entities.

14. As to claims 14 and 61, Marwell teaches “travel directions” (column 18, 61-66).

15. Claims 15-18 and 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by O’Neal et al. Patent No US 6,639,975 B1.

16. As to claims 15 and 62, O’Neal et al. teaches a system comprising: “a mechanism...” (column 7, lines 10-31) examiner interprets assisting as including the switching center allows the establishment of a communication connections; “one or more devices for generating...” (column 7, lines 60-67, and column 8 lines 1-6); “a processor for deriving information...” (column 11, lines 53-67, and column 12 lines 1-4); and “a server for providing information...” (column 11, lines 30-51).

17. As to claims 16-18 and 63-65, O’Neal further shows “a uniform resource locator” and “an internet” (column 9, lines 59-67 and column 10, lines 1-6).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 9 and 56 rejected under 35 U.S.C. 103(a) as being unpatentable over Marwell as applied to claims 1 and 8 or 51 and 55 above, and further in view of Zamora-Mckelvy et al. Patent No. US 6,519,616.

21. As to claims 9 and 56 Marwell does not detail including "search categories". Zamora-Mckelvy et al describes a system including "search categories" (column 9 lines 13-20).

22. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Zamora-Mckelvy and Marwell because categories simplify the search by allowing the listings to be divided up into easily understandable groups in the database system improving the utility of the DP system.

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23. Claims 11-13 and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marwell as applied to claims 1, 8, and 10 or 51, 55, and 57 above, and further in view of Golding et al. Patent No. US 6,640,218 B1.

24. As to claims 11 and 58, Marwell does not detail "selected as a function of the number of searches..." Golding describes a system including "selected as a function of the number of searches..." (column 7 lines 50-64, column 12 lines 62-67 and column 13 lines 1-16).

25. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Golding and Marwell because Golding provides a ranking based on the popularity of an item based on recent interest as shown by searches run on the data base system improving the versatility of the DB system.

26. As to claims 12 and 59, Maxwell details "restaurants" (column 18, 61-67 and column 19, lines 1-3).

27. As to claims 13 and 60, Marwell does not detail "movies" however, movies are well known in the art and it would be obvious for a directory service to be able to find a telephone number for the location showing the movies and even provide further services such as reserving a ticket to complement services detailed by Marwell such as making a reservation at a restaurant (column 18, 61-67 and column 19, lines 1-3).

28. Claims 19-28 and 66-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neal as applied to claims 15 and 62 above, and further in view of Marwell et al. Patent No. US 6,404,884.

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29. As to claims 19 and 66, O'Neal does not detail "receiving from the user communication calls requesting assistance". Marwell describes a system including "receiving from the user communication calls requesting assistance" (column 8, lines 48-66).

30. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Marwell and O'Neal because O'Neal specifies an individualized billing system for a call communication service however such a service commonly is expected to not only bill a customer but also provide other services such as directory and call assistance Marwell provides a individualized directory and call assistance service for the communication system improving the utility of the communications system of the DP system.

31. As to claims 20, 21, 67, and 68, Marwell details "wireless telephones" (column 4, lines 50-59).

32. As to claims 4, Maxwell describes including "a personal information manager (PIM)" (column 17, lines 6-43).

33. As to claim 23, Marwell details "switching facilities" (column 4, lines 50-59).

34. As to claims 24-28 and 70-74, Marwell describes "data concerns events" (column 9, lines 61-67, and column 10 lines 1-6 and 42-49) the telephone ID of caller concerns the events of searching for entities as it is used in the search for the contact list associated with the user identified by the users telephone number (column 9, lines 61-67, and column 10 lines 1-6 and 42-49).



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*Conclusion*

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

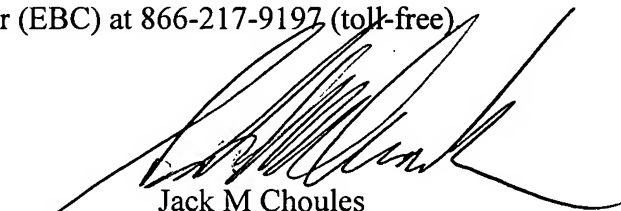
Kuftedjian et al      US 6,401,090 B1      Directory selected based on number dialed.

Scolini et al      US 2003/0233321 A1      Online communications billing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules  
Primary Examiner  
Art Unit 2167

7 January 2005